

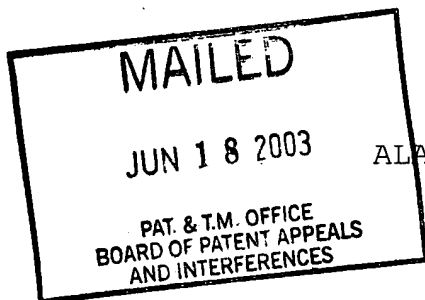
THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte RAYMOND DUBOUIS,
ALAIN POUCHELON and CHRISTIAN PUSINERI

Appeal No. 2003-0046
Application 09/331,959

REMAND

Before GARRIS, PAK, and DELMENDO, Administrative Patent Judges.
PAK, Administrative Patent Judge.

REMAND TO THE EXAMINER

Pursuant to 37 CFR § 1.196(a) (2001), we remand this
application to the examiner for appropriate action consistent
with the views expressed below.¹

¹ On May 19, 2003, the appellants' representative was
(continued...)

At pages 2 and 4 of the Answer, the examiner set forth the following rejections:

- 1) Claims 1 through 21 under 35 U.S.C. § 103 as unpatentable over the disclosure of Takita et al.; and
- 2) Claims 1 through 21 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of JP 50-97644 (its corresponding English translation of record) and Matsushita.

To rebut the examiner's rejections in the Answer, the appellants submitted a Reply Brief containing new arguments (e.g., arguments relying on new evidence) along with a copy of pages 229-231 of Chemistry and Technology of Silicones by Walter Noll (1968). See the Reply Brief filed August 5, 2000, Paper No. 26. In response, the examiner stated (the Office action dated September 24, 2002, page 2 (Paper No. 28)) that

¹(...continued)
informed that an oral hearing scheduled to be held on May 20, 2003 was vacated since this case was not ready for a decision on the merits at that time.

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[t]he reply brief filed 8/5/02 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

The examiner did not comment on the status of this new literature evidence attached to the Reply Brief in the form of an exhibit. See the record in its entirety.

37 CFR § 1.193(b) (2001) does not authorize the examiner to disapprove the entry of the appellants' Reply Brief containing new arguments. Nor does it authorize the examiner to address the appellants' new arguments in the Reply Brief via a Supplemental Answer absent our permission. However, it does not preclude the examiner from determining whether or not any new evidence submitted after an appeal should be entered.

37 CFR § 1.195 (2001) controls the admission status of any new evidence submitted after an appeal. Specifically, it states that

[a]ffidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.

The examiner, however, does not indicate the status of the above-mentioned newly submitted literature evidence, much less supply

any reasons for denying or approving entry of the above-mentioned newly submitted literature evidence.

Therefore, we order the examiner to:

- 1) clarify the status of the newly submitted literature evidence referred to above (entered or not entered);
and
- 2) submit a Supplemental Answer addressing any new arguments in the Reply Brief not responded to in the Answer pursuant to 37 CFR § 1.193(b)(1) (2001).

In addressing any new arguments in the Reply Brief, we remind the examiner of the procedural guidelines set forth in In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986), which states in relevant part:

If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, **prior art references, or argument**, the entire merits of the matter are to be reweighed. [Citation omitted.] [Emphasis ours.]

This application, by virtue of its "special" status, requires an immediate action on the part of the examiner. See MPEP § 708.01 (8th Ed., August 2001). It is important that the examiner promptly inform the Board of any action affecting the

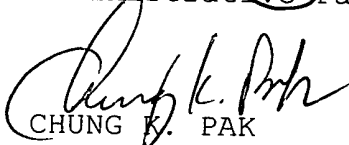
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appeal in this case (e.g., abandonment, issue, reopening prosecution).

REMANDED



BRADLEY R. GARRIS
Administrative Patent Judge



CHUNG K. PAK
Administrative Patent Judge



ROMULO H. DELMENDO
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
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CKP:psb

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